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PATENT 7284/52829-R

# Not For Filing; Request For Interview IN THE UNITED STATES PATENT AND TRADEMARK OFFICE By Fax (703) 305-0285 FAX RECEIVED

Applicant

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**GROUP 3600** 

For

LOCATION OF MISSING VEHICLES

Group

3662

Examiner

Theodore Blum

For Reissue of Original Patent No. 5,418,537

1185 Avenue of the Americas New York, New York 10036 (212) 278-0400 October 20, 2000

# **REMARKS**

Assistant Commissioner for Patents Washington, D.C. 20231

This is further to the voice mail message I left you today. I am transmitting herewith a passage from MPEP §1412.02. The passage marked A indicates that where reissue claims include a material, narrowing limitation not present in the claims deliberately canceled from the application for the original patent, there is no improper recapture.

Our contention is that our new reissue claims avoid recapture because they include a "material, narrowing limitation not present in the claims deliberately canceled from the application for the original patent."

PATENT 7284/52829-R

I will be in Washington next Tuesday, October 24, and would like to interview you in your office at about 11:00 a.m., if that is convenient.

Respectfully submitted,

COOPER & DUNHAM LLP

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DSD:lo

§ 1412.02

M.P.E.P

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newly recognized benefit from composition X. A claim to composition X or a method of use thereof would not be permitted in a reissue application, because the original patent specification contained an explicit statement of intent not to claim composition X or a method of use thereof.

In most instances, however, the mere failure to claim a disclosed embodiment in the original patent (absent an explicit statement in the original patent specification of unsuitability of the embodiment) would not be grounds for prohibiting a claim to that embodiment in the reissue.

## § 1412.02 Recapture of Canceled Subject Matter

A reissue will not be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent. In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); Ball Carp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1989); In re Wadlinger, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); In re Richman, 409 F.2d 269, 276, 161 USPQ 359, 363-64 (CCPA 1969); In re Willingham. 282 F.2d 353, 127 USPQ 211 (CCPA 1960). The Federal Circuit stated the following principles in Clement:

(1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection; the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to a prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

131 F.3d at 1469-70, 45 USPQ2d at 1165. See MPEP § 1412.03 as to broadening claims.

Impermissible recapture occurs in a reissue where the claims in the reissue are of the same scope as, or are broader in scope than, claims deliberately canceled in an application to obtain a patent. Where such claims also include some narrowing limitation not present in the claims deliberately canceled in the application, the examiner must determine whether that narrowing limitation has a material aspect to it. If the narrowing limitation has a material aspect to it, then there is no recapture. However, if the narrowing limitation is incidental, mere verbiage, or would be inherent even if not recited (in view of the specification), then the claims should be rejected under 35 U.S.C. 251 using form paragraph 14.17.

#### ¶ 14.17 Rejection, 35 U.S.C. 251, Recapture

Claim [1] rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately, cunceled in the application for the putent upon which the present reissue is based. As stated in Bull Corp. v. United States, 221 USPQ 289, 295 (Fed. Cir. 1984):

"The recupture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application." [2]

### Examiner Note:

In bracket 2, the examiner should expluin the specifics of why recapture exists. See MPEP \$ 1412.02

A patentee may file a reissue application to permit consideration of process claims which qualify for \$\frac{1}{2}\$ U.S.C. 103(b), treatment if a patent is granted on an application entitled to the benefit of 35 U.S.C. 103(b), without an election having been made as a result of error without deceptive intent. See MPEP § 706.02(n). This is not to be considered a recapture. The addition of process claims, however, will generally be considered to be a broadening of the invention (Ex Parte Wikdahl, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the "article" claims) or in canceling claims directed to this statutory category of invention must have been made as a result of error without deceptive intent. The addition of these "article" claims will generally be considered to be a broadening of the invention (Ex Parte Wikduhl, 10 USPQ2d 1546 (Bd. Parte Wikduhl).

(Matthew Bender & Co., Inc.)

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